

REMARKS

Applicant respectfully requests entry and consideration of the above amendments even though presented after a final rejection. Applicant submits that the amendments do not raise new issues or require a new search. Further, entry and consideration of the amendments may isolate issues for potential allowance or appeal. The amendments were not presented earlier in the prosecution due to a better understanding of the Examiner's position as reflected in the latest Office Action.

Summary

Claims 1, 3-10, 12-14, 17-23, 25-29, 31 and 33 stand in this application. Claims 2, 11, 15, 16, 24, 30 and 32 have been canceled without prejudice. Claims 1, 14, 21, 27, 31 and 33 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 14, 21, 27, 31 and 33 in order to facilitate prosecution on the merits.

35 U.S.C. § 102

At page 2, paragraph 2 of the Office Action claims 6-7, 10 and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by United States Patent Number (USPN) 6,321,276 to Forin ("Forin"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See* MPEP § 2131, for example. Applicant submits that Forin fails to teach each and every element recited in claims 6-7, 10 and 13 and thus they define over Forin. For example, with respect to claim 6, Forin fails to teach, among other things, the following language:

wherein the second physical address is embedded within
the first physical address.

According to the Office Action, this language is disclosed by Forin at column 18, lines 3-7. Applicant respectfully disagrees.

Applicant respectfully submits that Forin fails to disclose, teach or suggest the missing language. Forin at the given cite, in relevant part, states:

The VI kernel agent translates the virtual memory address
of the descriptor to a physical memory address utilizing the
host page tables and communicates the physical memory
address to the recoverable I/O request processor.

Applicant respectfully submits that this is different than the above recited teaching of claim 6. Applicant respectfully submits that Forin, arguably, teaches translating a virtual memory address to a physical memory address utilizing page tables. Applicant submits that this is different than “the second physical address is embedded within the first physical address” as recited in claim 6.

Furthermore, Applicant respectfully submits that Forin fails to even mention embedding a second physical address within a first physical address. In contrast, Forin, arguably, teaches mapping the virtual memory address to the physical memory address, indicating that the physical memory address is not in fact embedded in the virtual memory address as recited in claim 6. Consequently, Forin fails to disclose all the

elements or features of the claimed subject matter. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 6. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 7, 10 and 13, which depend from claim 6 and, therefore, contain additional features that further distinguish these claims from Forin.

35 U.S.C. § 103

At page 5, paragraph 3 of the Office Action claims 1-5, 8-9, 12 and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Forin in view of US Patent Publication Number 2002/0062402 to Regnier et al. ("Regnier"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

At page 13, paragraph 4 of the Office Action claims 14 and 17-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Forin in view of Regnier and further in view of US Patent Publication Number 2002/0016926 to Nguyen et al. ("Nguyen"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

At page 21, paragraph 5 of the Office Action claims 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Forin in view of Nguyen. Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish

a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1, 3-5, 8-9, 12, 14, 17-23, 25-29, 31 and 33. Therefore claims 1, 3-5, 8-9, 12, 14, 17-23, 25-29, 31 and 33 define over the cited references.

Applicant respectfully submits, as recited above, that Forin fails to teach, suggest or disclose at least “wherein the second physical address is embedded within the first physical address” as recited in independent claim 6. Moreover, Applicant respectfully submits that independent claims 1, 14, 21, 27, 31 and 33 have been amended to recite features similar to those recited in claim 6. Applicant respectfully submits that Forin is relied upon in the Office Action to teach the above recited language in each of the independent claims.

Applicant respectfully submits that Forin fails to teach, suggest or disclose the missing language. Furthermore, Applicant respectfully submits that neither Regnier nor Nguyen teach the missing language. Therefore, Applicant respectfully submits that claims 1, 6, 14, 21, 27, 31 and 33 not obvious and are patentable over the cited references, taken alone or in combination, for reasons analogous to those presented with respect to claim 6 above. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 1, 14, 21, 27, 31 and 33. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 3-5, 8-9, 12, 17-20, 22, 23, 25, 26, 28 and 29 that depend from claims 1, 6, 14, 21, 27, 31 and 33 respectively, and therefore contain additional features that further distinguish these claims from Forin, Regnier and Nguyen, taken alone or in combination.

For at least the reasons given above, claims 1, 3-5, 8-9, 12, 14, 17-23, 25-29, 31 and 33 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1, 3-5, 8-9, 12, 14, 17-23, 25-29, 31 and 33 is respectfully requested. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken

alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

Moreover, Applicant respectfully submits that the above amendments do not necessitate further search because the subject matter of the canceled dependent claims has been incorporated into the independent claims from which they formerly directly depended. As a result, the claimed embodiments have been considered in the Office Action.

It is believed that claims 1, 3-10, 12-14, 17-23, 25-29, 31 and 33 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present patent application.

Respectfully submitted,

KACVINSKY LLC

A handwritten signature in black ink, appearing to read 'John F. Kacvinsky', with a long horizontal flourish extending to the right.

John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

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